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TECHNOLOGY CENTER R3700

UNITED STATES PATENT AND TRADEMARK OFFICE

<b>APPLICANT:</b>	Steven A. Weiss	)	
<b>SERIAL NO.:</b>	09/921,076	)	<b>ART UNIT: 3713</b>
<b>FILED:</b>	August 2, 2001	)	
<b>TITLE:</b>	A Gaming Device Having First Chance Means and Serially Dependant Second Chance Means	)	<b>EXAMINER: Nguyen, K.</b>

Commissioner for Patents  
Washington, DC 20231

**RECEIVED**  
SEP - 2 2003  
TECHNOLOGY CENTER 3700

**PETITION FOR WITHHOLDING OF ABANDONMENT**

Sir:

Applicant received a Notice of Abandonment with a date of mailing of August 12, 2003. The holding of abandonment was based on the premise that applicant failed to timely file an Amendment responsive to the Office Action dated November 20, 2002.

It is respectfully submitted that this premise of failure to timely respond is false, therefore the conclusion that the case stands abandoned is also false and retraction of the Notice of Abandonment, resuming prosecution on the merits is respectfully requested. The applicant timely filed an amendment on May 19, 2003. The applicant submits the following facts and evidence in support of the position taken in this Petition:

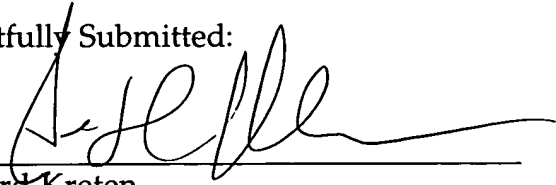
Attached hereto as Exhibit "A" is a copy of the Amendment (including the Certificate of Mailing under 37 C.F.R. §1.8(a) dated May 19, 2003) as timely filed on May 19, 2003.

Attached hereto as Exhibit "B" is a copy of the return receipt card, date stamped received at the Patent and Trademark Office on May 22, 2003.

In view of the foregoing, it is respectfully requested that the Commissioner withhold abandonment of this case.

Dated: August 29, 2003

Respectfully Submitted:

A handwritten signature in black ink, appearing to read 'Bernhard Kreten', written over a horizontal line.

Bernhard Kreten  
Attorney for Applicant  
Telephone: (916) 930-9700  
Registration No.: 27,037

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT:	Steven A. Weiss	)	
SERIAL NO.:	09/921,076	)	ART UNIT: 3713
FILED:	August 2, 2001	)	
TITLE:	A Gaming Device Having First	)	EXAMINER: Nguyen, K.
	Chance Means and Serially	)	
	Dependant Second Chance Means)	)	


To: Commissioner for Patents  
Washington, DC 20231

**AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT**

It is believed that no fees are due with respect to the filing of the appended Petition for Withholding of Abandonment. However, should any fees be due with respect to this filing, such fees should be charged to deposit account 11-1734, attorney docket number 31069-pa.

Dated: August 29, 2003

Respectfully Submitted:

  
BERNHARD KRETEN  
Applicant's Attorney  
Telephone (916) 930-9700  
Registration No.: 27,037

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Steven A. Weiss

SERIAL NO.: 09/921,076

FILED: August 2, 2001

FOR: A Gaming Device Having  
First Chance Means  
and Serially Dependant  
Second Chance Means

ART UNIT: 3713

EXAMINER: Nguyen, K.

To: Mail Stop AF  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

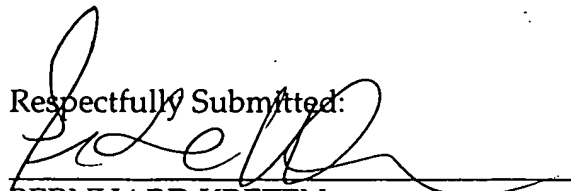
EXTENSION OF TIME

A check in the amount of \$966.00 is enclosed, \$930.00 of which is to be received as the extension fee to respond to the Office Action dated November 20, 2002, now due May 20, 2003 and the \$36.00 is to be received as the fee for the presentation of additional claims.

Any added fees due with respect to this document or the amendment filed herewith should be charged to deposit account 11-1734, attorney docket number 31069-pa.

Dated: May 19, 2003

Respectfully Submitted:

  
BERNHARD KRETEN  
Applicant's Attorney  
Telephone (916) 930-9700  
Registration No.: 27,037

[Extension of Time]

EXHIBIT "A"

ATTORNEY'S DOCKET NO. BK/31069-pa

In re the application of: Steven A. Weiss  
Serial No.: 09/921,076  
Filed: July 31, 2001  
For: A Gaming Device Having First Chance Means and Serially  
Dependant Second Chance Means

Mail Stop AF  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

Sir:  
Transmitted herewith is an amendment in the above-identified application.

\_\_\_\_\_ No additional fee is required.

The fee has been calculated as shown below:

						Other Than A	
(Col 1)		(Col 2)		(Col 3)Small Entity: Small Entity:			
Claims	Remaining	Highest No.	Present	Rate	Addit.	Rate	Addit.
After	Amendment	Previously	Extra		Fee	OR	Fee
Total:	*26 Minus	**24	2	x 9.=	0.	x 18.=	36.00.
Indep.:	*6 Minus	**6	0	x 42.=	0.	x 84.=	0.
Total:							\$36.00.

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid For" in this space is less than 20, write "20" in this space.

\*\*\*If the "Highest Number Previously Paid For" in this space is less than 3, write "3" in this space. The "Highest Number Previously Paid For" (Total of Independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment or the number of claims originally filed.

A check in the amount of \$966.00 is enclosed, \$36.00 of which is to cover the filing fee for the presentation of additional claims and the \$930.00 of which is to cover the Extension of Time fee.

The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 11-1734. A Duplicate copy of this sheet is enclosed.

XXX Any additional filing fees required under 37 CFR 1.16 for the presentation of extra claims.

\_\_\_\_\_ Any patent application processing fees under 37 CFR 1.17.

Dated: May 19, 2003

  
BERNHARD KRETEN, Reg. No. 27,037

[Amendment Transmittal Letter]

**EXHIBIT** A

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Steven A. Weiss

SERIAL NO.: 09/921,076

FILED: August 2, 2001

FOR: A Gaming Device Having  
First Chance Means  
and Serially Dependant  
Second Chance Means

ART UNIT: 3713

EXAMINER: Nguyen, K.

To: Mail Stop AF  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

AMENDMENT

Sir:

Responsive to the Office Action dated November 20, 2002, kindly enter the following amendments:

**IN THE SPECIFICATION**

**Kindly replace paragraph one at page two with the following:**

This application is a continuation-in-part of U.S. Serial No. 08/950,280, filed October 14, 1997, now abandoned.

**Kindly replace paragraph three at page ten with the following:**

The tower portion 14, on the other hand, supports three wheels 28, 30, 32, each rotatably attached to its own respective stepping motor 60. Indicia 34, 38, 40 are presented upon each wheel as well, along with another special symbol 36. A pointing device 46 is provided for indicating an outcome to a player. Fans (not shown) may provide a cooling source for the invention.

IN THE ABSTRACT

Kindly replace paragraph one at page 18 with the following:

A gaming device having a first chance opportunity and a second, serially dependent, chance opportunity is provided. The first chance opportunity is preferably a multiple reel game having a special outcome for triggering the second chance opportunity. The second chance opportunity is preferably a plurality of wheels rotatably coupled to a tower atop the reel game. The first of the wheels will spin and provide an outcome upon a specified outcome of the reel game. Each successive wheel will spin when a specified outcome is depicted on a previous wheel. This will continue until either the specified outcome does not occur or the last wheel is spun. In another version, plural wheels are each uniquely related - one to a given reel, such that a certain reel outcome will energize its associated wheel only. Multiple wheels, when synchronized to a certain outcome, lead to a bigger wheel for a jackpot.



### IN THE CLAIMS

Claim 1 (original) - A gaming apparatus, comprising, in combination:

a wager input means;

a game processor enabled by said wager input means;

display means driven by said processor upon wager input;

said display means including indicia defining an outcome;

comparator means evaluating the outcome versus a payable;

and a plurality of wheel devices, serially enabled including an output bonus for each said wheel device; and

a first said wheel device enabled by an outcome of said display means and each successive said serially enabled wheel device is enabled only when a previous wheel displays a mandated outcome.

Claim 2 (original) - The gaming apparatus of claim 1 wherein said plurality of wheel devices includes at least two wheels.

Claim 3 (original) - The gaming apparatus of claim 2 further comprising an elongate monolith upon which said wheels are rotatably coupled and a pedestal base upon which said display means is mounted, wherein said monolith rests upon said base.

Claim 4 (original) - The gaming apparatus of claim 3 wherein said display means comprises at least three reels.

Claim 5 (original) - The gaming apparatus of claim 4 wherein said reels are displayed on a video monitor presenting a continuous series of various symbols disposed sequentially on said reels.

Claim 6 (original) - The gaming apparatus of claim 4 wherein said reels have an annular series of various symbols disposed about a periphery of said reels.

Claim 7 (original) - The gaming apparatus of claim 4 wherein said wheels are circular and have indicia disposed about the perimeter of said wheels, said indicia including numerals and a special symbol corresponding to said mandating outcome.

Claim 8 (original) - The gaming apparatus of claim 7 wherein said numeric indicia on each said wheel increases from the first wheel to the next such that said output bonus corresponds to said numeric indicia and said output bonus is enhanced with each successive potential wheel.

Claim 9 (original) - The gaming apparatus of claim 8 wherein said wheels are arranged in a vertical column.

Claim 10 (original) - A method for entertaining with a multi-wheel gaming device, the steps including:

- inputting a wager;
- enabling a game;
- spinning a plurality of reels on a display by means of a computer processor;
- displaying an outcome on a display;
- comparing the outcome to a pay table;
- awarding a bonus credit when the outcome displayed on the reels is a winning outcome;
- spinning a first wheel when a first special symbol appears on the last of the reels;
- displaying an outcome on the first wheel;
- awarding a bonus credit when the outcome displayed is a number;

spinning a second wheel when a second special symbol is indicated on the first wheel;

awarding a bonus credit when the outcome displayed is a number;

spinning a third wheel when the second special symbol is indicated on the second wheel;

awarding a bonus credit when the outcome displayed on the third wheel is a number; and

awarding a maximum bonus credit when the second special symbol is indicated on the third wheel.

Claim 11 (original) - A method for providing entertainment via a multi-wheel gaming device, the steps comprising:

inputting a wager;

enabling a processor;

displaying an outcome;

comparing the outcome to a paytable;

serially enabling a plurality of wheel devices upon a mandated display outcome; and

spinning each wheel, one at a time, only when a previous outcome is a mandated outcome recognized as qualifying for a serial wheel.

Claim 12 (original)- A method for providing entertainment via a multi-wheel gaming device, the steps comprising:

allowing a wager;

displaying a random outcome on a first display;

enabling a series of second displays only as a function of a first display outcome; and

allowing a second and subsequent series of second displays to be successively enabled only as a function of a previous qualifying outcome from and immediately preceding second display.

Claim 13 (currently amended) - A gaming device, comprising, in combination:

a wager input means;

a processor enabled by said wager input means;

a multiple reel display having N individual reels, a multiple wheel display having N wheels, means for coupling one wheel per reel and an such that at least one outcome of for each said reel which will enables its respective wheel.

Claim 14 (currently amended) - A method for gaming, the steps including:

receiving a wager; there after enabling N reels;

and enabling a plurality of N wheels based only on whether a said reel with which a said wheel is related has a specific output.

Claim 15 (original) - The device of claim 13 wherein said respective wheel of said reel is enabled only by one outcome and said wheel remains inoperative otherwise.

Claim 16 (currently amended) - The device of claim 13 ~~wherein~~ further comprising comparator means ~~are provided for~~ assessing outcomes on said N wheels including means to enable a further award based upon at least one outcome on said N wheels.

Claim 17 (currently amended) - The device of claim 16 wherein said further award includes an odometer type display showing a face value of a present, potential

payout and said further award includes means to bestow either said face value, a multiplier of said face value ~~on~~ or an unrelated amount.

Claim 18 (original) - The device of claim 17 wherein said multiplier is an integer.

Claim 19 (original) - The device of claim 17 wherein said multiplier is a fraction.

Claim 20 (original) - The device of claim 17 wherein said further award includes a wheel larger than said N wheels and disposed above said N wheels, said N wheels disposed above said N reels in substantial vertical alignment.

Claim 21 (original) - The method of claim 14 further including comparing an outcome exhibited on said N wheels, and enabling a further award based on one specific outcome being exhibited.

Claim 22 (original) - The method of claim 21 further including enabling chance means upon the occurrence of the one specific outcome to determine the further award.

Claim 23 (original) - The method of claim 22 further including displaying a prize available as the further award and bestowing to a player an award of the prize after modifying the prize upon executing the chance means.

Claim 24 (original) - The method of claim 23 including multiplying the prize by a number where the number is either an integer or a fraction.

Claim 25 (new) - The device of claim 18 wherein said integer doubles said face value.

Claim 26 (new) - The device of claim 19 wherein said fraction halves said face value.

### REMARKS

The Office Action dated November 20, 2002 has been received, its contents carefully noted, and the applied citation thoroughly studied. Accordingly, the foregoing revisions to the specification and claims are tendered with the conviction that patentable contrast has now been made manifest over the known prior art. Accordingly, all rejections tendered by the Examiner in the above-referenced Office Action are hereby respectfully traversed and reconsideration is respectfully requested.

Figure 5 of the drawings is modified subject to the Examiner's approval to include the objected to missing reference numerals.

The text and claim 16 have been modified to conform to the Examiner's perception of correctness.

Claim 13 has been amended to extinguish the Examiner's perceived over breadth concerns and claims 13 and 14 are amended to specify patentable subject matter beyond any residual doubt capable of being reasonably entertained by the Examiner.

The Examiner's reliance on Morrow ('820) is misplaced. The standard for obviousness articulated and applied by the Examiner is legally incorrect. Morrow is not the least concerned with dedicating an individual reel of a series to an individual wheel of a series such that each reel enables its respective wheel.

Morrow - not the Examiner - is the arbiter of that which is within the scope of that patent. Morrow provides written guidance for permissible "variations and modifications" at column 10, lines 6-30. No where does Morrow discuss, desire, postulate or conjecture on the feature claimed by applicant of one reel dedicated to one wheel.

It is Black Letter Law the Patent and Trademark Office's burden is to establish a prima facie case of non-obviousness. The Patent and Trademark Office has met its burden only when it fully describes: "1) What the reference discloses, teaches and suggests to one skilled in the art; 2) What the reference lacks in disclosing, teaching or suggesting vis-à-vis the claimed features; 3) What particular teaching or suggestion is being relied upon either via a reference itself or knowledge of person of ordinary skill in the art; 4) A statement explaining the proposed modification in order to establish the prima facie case of obviousness; and finally 5) the motivation behind the statement of obviousness which comes from three sources: a) teachings of the prior art; b) nature of the problem to be solved; or c) knowledge of persons of ordinary skill in the art", *see In re Rouffet* 47 USPQ2d 1453 (Fed. Cir. 1998).

The Examiner has failed to meet these threshold requirements to establish prima facie obviousness. In the absence of such a prima facie showing, the Examiner's rejection cannot stand.

The Examiner has failed to find motivation for the modification to Morrow in any written form except in applicant's disclosure. This is impermissible hindsight and is tantamount to using applicant's own disclosure against applicant.

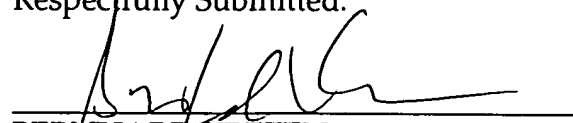
Undersigned has added two claims which multiplies a reward by 2 and divides an award by half. The Examiner could not locate the concept of an integer multiplier or fraction divider in the text. These examples are found bridging pages 12 and 13.

///

In view of the foregoing, it is respectfully requested that the Examiner pass this case to issue. If, upon further consideration, the Examiner believes further issues remain outstanding or new ones have been generated, undersigned respectfully requests that the Examiner call undersigned to expeditiously resolve same.

Dated: May 19, 2003

Respectfully Submitted:

  
BERNHARD KRETEN  
Applicant's Attorney  
Telephone (916) 930-9700  
Registration No.: 27,037



UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Steven A. Weiss

SERIAL NO.: 09/921,076

FILED: August 2, 2001

FOR: A Gaming Device Having  
First Chance Means  
and Serially Dependant  
Second Chance Means

ART UNIT: 3713

EXAMINER: Nguyen, K.

To: Mail Stop AF  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

LETTER TO THE DRAFTSMAN

Subject to the Examiner's approval, kindly enter the enclosed one (1) sheet of formal drawing figures (comprised of figure 5) in place of figure 5 as originally filed in the above-identified case. Also enclosed is a red-lined version of Figure 5 for the Examiner's convenience.

Dated: May 19, 2003

Respectfully Submitted:

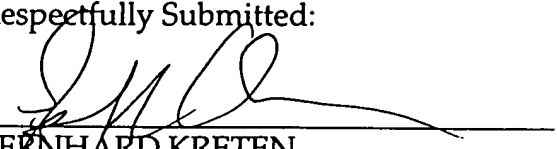
  
BERNHARD KRETEN  
Applicant's Attorney  
Telephone (916) 930-9700  
Registration No.: 27,037

EXHIBIT A

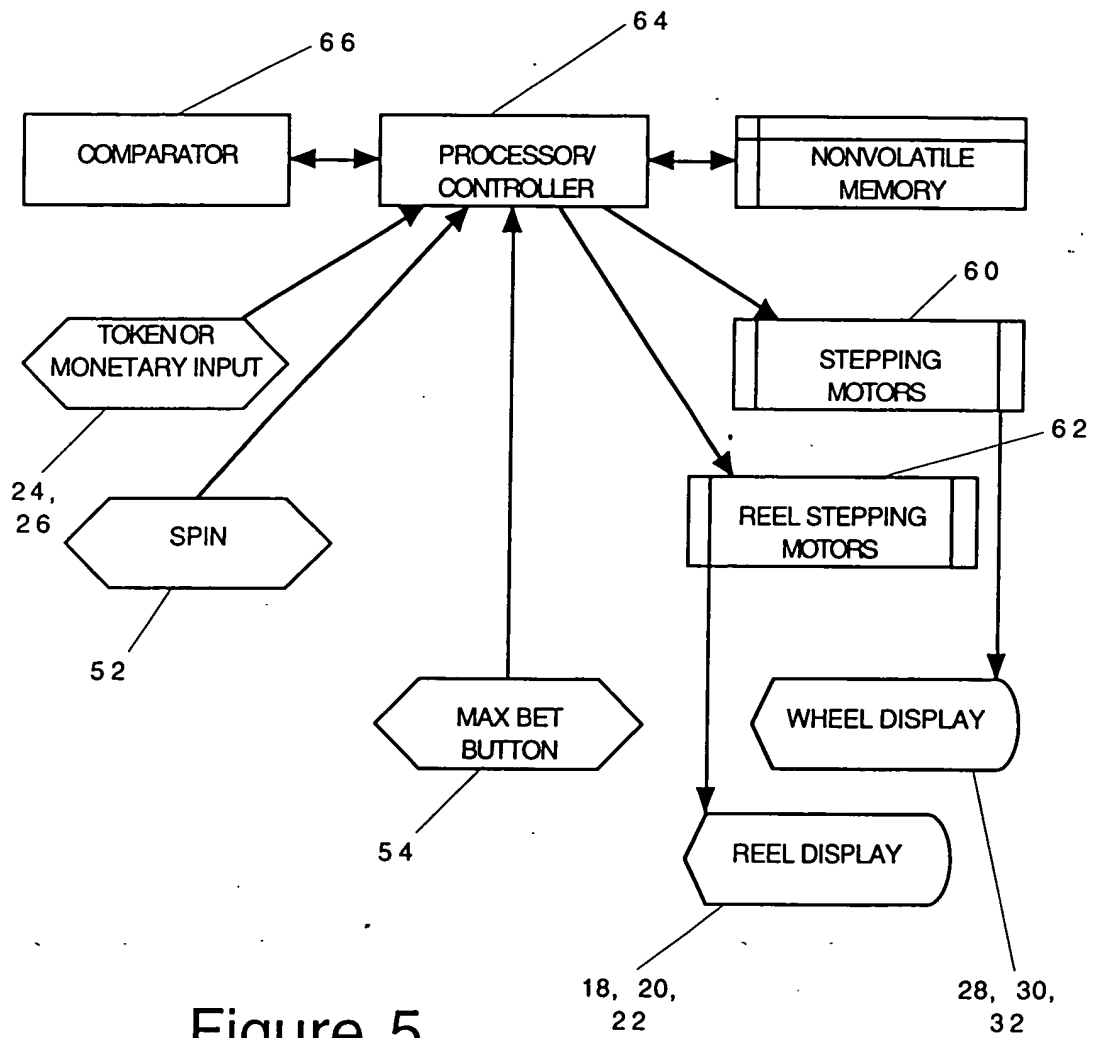


Figure 5

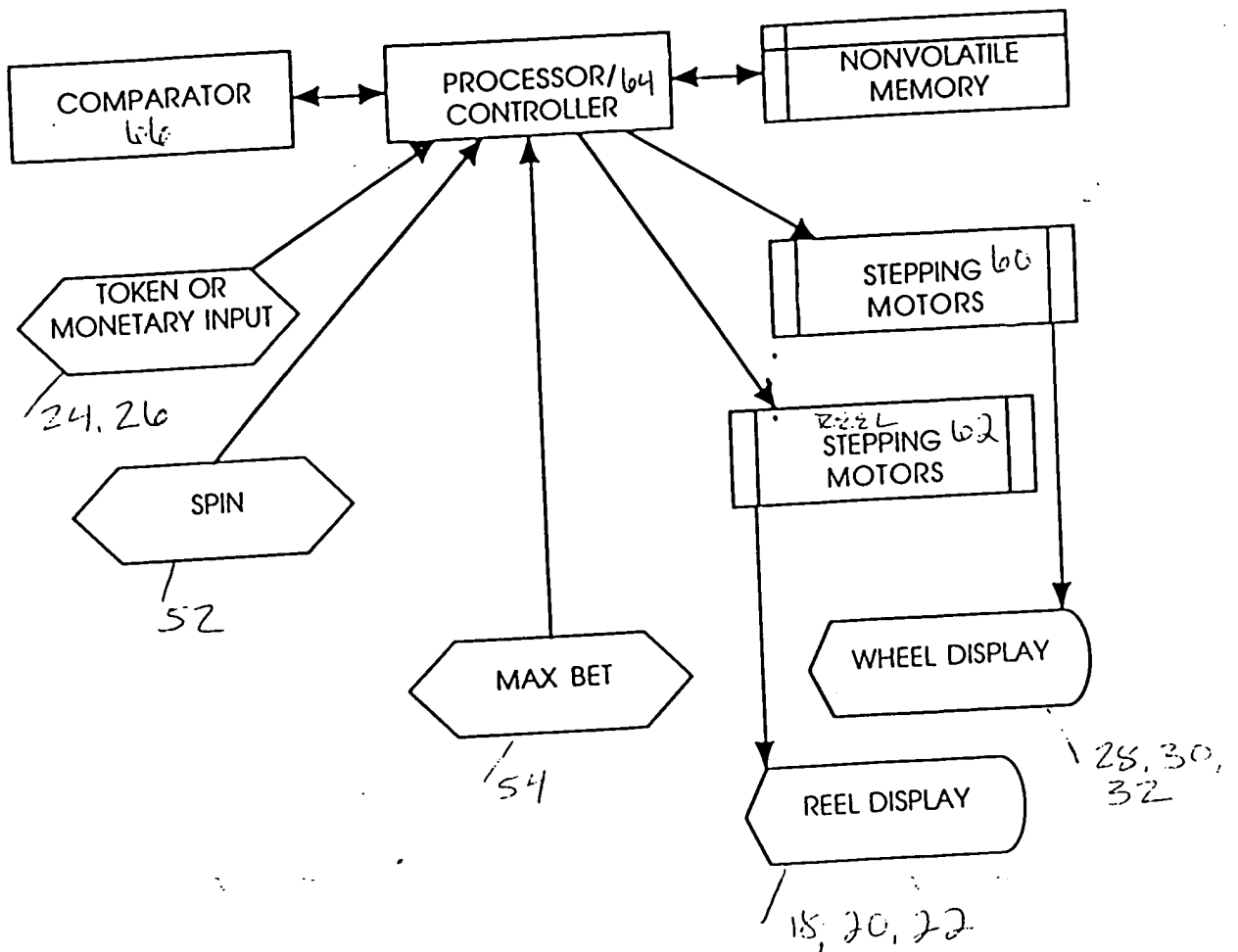


Figure 5

UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Steven A. Weiss

SERIAL NO.: 09/921,076

FILED: August 2, 2001

FOR: A Gaming Device Having  
First Chance Means  
and Serially Dependant  
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EXAMINER: Nguyen, K.

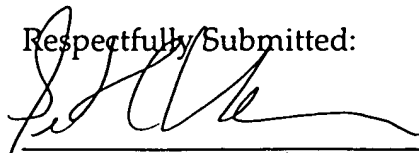
To: Mail Stop AF  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

REQUEST FOR PERSONAL INTERVIEW

Undersigned hereby specifically requests that the Examiner consider and suggest convenient times at which a personal interview with the Examiner may be conducted with undersigned to expedite resolution of this case. At that time any remaining details can be discussed which assures this case is suitable for passage to issue.

Dated: May 19, 2003

Respectfully Submitted:



BERNHARD KREten  
Applicant's Attorney  
Telephone (916) 930-9700  
Registration No.: 27,037

EXHIBIT "A"

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

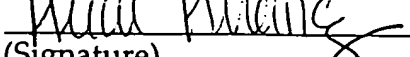
Applicant: Steven A. Weiss  
Serial No.: 09/921,076  
Filed: August 2, 2001  
For: A Gaming Device Having First Chance Means and Serially  
Dependant Second Chance Means  
Paper: 1. An Amendment (responsive to the Office Action dated  
November 20, 2002);  
2. An Extension of Time (original and one copy);  
3. An Amendment Transmittal (original and one copy);  
4. A Letter to the Draftsman;  
5. One Sheet of Formal Drawing Figure (Fig. 5);  
6. One Sheet of Red-Lined Drawing Figure (Fig. 5);  
7. A Request for Personal Interview;  
8. A Check in the Amount of \$966.00; and  
9. A Return Receipt Card.

I hereby certify that the above identified correspondence, which is attached, is being deposited with the United States Postal Service as first class mail in an envelope addressed to:

Mail Stop AF  
Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

on May 19, 2003.

Heldi Hernandez

  
(Signature)

May 19, 2003

(Date of Signature)

EXHIBIT

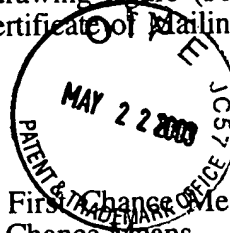
A

**PLEASE ACKNOWLEDGE RECEIPT OF:**

An Amendment (responsive to the Office Action dated November 20, 2002); An Amendment Transmittal (original and one copy); An Extension of Time (original and one copy); A Request for Personal Interview; a Letter to the Draftsman; One sheet of formal drawing figure (Fig. 5); One sheet of Red-Lined drawing figure (Fig. 5); a check in the amount of \$966.00; and a Certificate of Mailing under 37 C.F.R. §1.8(a).

Applicant: Steven A. Weiss  
Serial No.: 09/921,076  
Filed: August 2, 2001  
For: A Gaming Device Having First Change Means and  
Serially Dependant Second Chance Means

**31069-pa**



**EXHIBIT "B"**